



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Ronald S. Kuptzin
Cynthia G. Kuptzin
27 Rossie Street
Mystic, CT 06355

MAILED

OCT 06 2011

OFFICE OF PETITIONS

In re Patent No. 6,438,995 :
Issue Date: August 27, 2002 :
Application No. 09/619,286 :
Filed: July 19, 2000 :
Title of Invention: **CLASP FOR JEWELRY CHAIN:**

ON PETITION

This is a decision on the petition filed September 13, 2011, under 37 CFR 1.378(b), to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(h). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner.

The patent issued on August 27, 2002. The first maintenance fee due could have been paid during the period from August 27, 2005 to February 27, 2006 or, with a surcharge during the period from February 28, 2006 to August 27, 2006. Additionally, the second maintenance fee could have been paid during the period from August 27, 2009 to February 27, 2010 or, with a surcharge during the period from February 28, 2010 to August 27, 2010. Accordingly, this patent expired on August 27, 2006 for failure to timely remit the first maintenance fee.

A petition to accept the delayed maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(l)(1).

Petitioner argues that "We have been developing an interest in our patent for several years. In 2002 we were challenged by a law suit in Connecticut by claims that would have diverted our use of the patent. After a long and costly legal experience we finally prevailed. (See Superior Court Case #CV030565856). Unfortunately, during the exhausting process, we inadvertently allowed our payments to lapse for the maintenance of our status with the Patent Office. As we have recovered ourselves sufficiently to continue work on developing uses and applications for our patent, we realize we need to re-establish our relationship with USPTO. We have never abandoned our efforts to promote and deploy uses for the patent and herewith submit the appropriate forms and fees to update and reinstate. Enclosed, for your consideration, is the \$400.00 expediting fee. Obviously, we are sorry for any perceived disrespect to the Patent Office and are hopeful you can accommodate our reinstatement".

This petition lacks item (1) above.

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses identical language (i.e. "unavoidable delay").¹ Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.² In this regard:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.³

¹Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1989)).

²Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used by prudent and careful men in relation to their most important business").

³In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.⁴ That is, an adequate showing that the delay was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent.⁵

Petitioner's arguments have been considered but are not persuasive.

Based upon the arguments proffered, rather than unavoidable delay, the showing of record is of a lack of diligence on the part of petitioner to maintain the patent in force. The maintenance fee was not timely paid because of petitioner's preoccupation with defending a law suit and by their own admission, they "...inadvertently allowed our payments to lapse for the maintenance of our status with the Patent Office". In this instance no steps were taken to ensure timely payment of the maintenance fee. Therefore, petitioner's lack of diligence and preoccupation with other matters which took precedence over the above-identified patent, does not constitute unavoidable delay.⁶

In view thereof, no evidence has been provided to establish that the delay in payment of the maintenance fee was unavoidable.

For all the reasons listed above, petitioner has not carried the burden of proof to establish to the satisfaction of the Director that the delay was unavoidable. There is a distinct difference between an unavoidable delay which, had there been reasonable care exercised, could not have been prevented and one that was inadvertent or the result of a mistake.

Since petitioner has not provided enough information for a determination that reasonable care was in fact exercised to ensure that the maintenance fee would be paid timely and that therein the delay was unavoidable, the argument fails.

As petitioner has not provided a showing of evidence to satisfy the requirements of a grantable petition under the unavoidable standard, the petition will be dismissed.

Further correspondence with respect to this matter should be addressed as follows:

⁴ Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

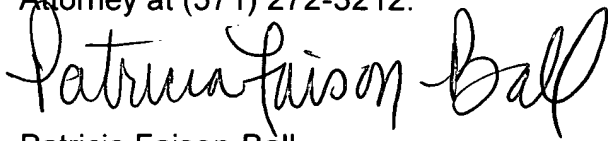
⁵ Id.

⁶ See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

By mail: Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

A handwritten signature in black ink, reading "Patricia Faison-Ball". The signature is written in a cursive, flowing style with a large, prominent "P" and "B".

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions